

REMARKS

Applicants are filing the present Amendment along with a Request for Continued Examination. Applicants presume that all amendments filed by applicants on December 30, 2003 will be entered prior to entry of the present Amendment. Upon entry of the present amendments, claims 40, 42, 43, 57, 58, 63, and 71 to 119 will be pending in the application. Applicants have amended claims 42 and 43 to delete the term "naturally occurring" and have amended claims 40, 58, 71 and 73 to recite that the amino acid sequence of the parathyroid hormone receptor recited in part (a) of each of these claims is at least 30% identical to SEQ ID NO:20. Support for these amendments can be found throughout the specification, e.g., at page 3, lines 22 to 32. Applicants have added new claims 74 to 119. These new claims are similar to canceled claims 41, 52 to 56, 60 to 62, 64 to 66, and 68 to 70. The amendments and new claims add no new matter to the present application.

Applicants thank Examiner Pak for his time to conduct telephone interviews with applicants' representatives on January 13, 2004, January 20, 2004 and April 13, 2004, and appreciate his guidance as to what would be required to overcome the rejections of record. All of the pending claims were discussed during those interviews. The possibility of filing a Request for Continued Examination was discussed during the interview of April 13, 2004. Further details of subjects discussed during the two previous interviews are provided below. Applicants understand that, upon amending the claims as discussed during the interviews, the claims would be in condition for allowance. Such action is respectfully requested.

Applicants also understand that upon allowance of generic claims 40 and 58, they would be entitled to examination of all claims that depended from claims 40 and 58. As applicants canceled those dependent claims (claims 41, 52 to 56, 59 to 62 and 64 to 70) in their Amendment in Reply to Final Office Action (as they were instructed to do in the Final Office Action), they have added new claims 74 to 79, 86 and 89 to 94 in the present amendment. Applicants have also added claims 80 to 85, 87, 88, and 95 to 120, which mirror claims 42, 43, 57, 72, 63, 74 to 79, 86 and 89 to 94, but depend from claims 71 and 73.

Should the present submission be non-persuasive in any way, the Examiner is kindly asked to telephone the undersigned to resolve any remaining issues.

I. Rejections under § 112, second paragraph

The rejection of claims 40, 42, 43, 57, 58, 63, and 71 to 73 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite due to applicants' use of the term "parathyroid hormone receptor" was discussed during the interviews. The Examiner indicated that the arguments applicants presented in their previous Amendment were persuasive on this issue. Accordingly, applicants request that this rejection be withdrawn.

Also discussed was the rejection of claims 42 and 43 as allegedly indefinite due to applicants' use of the term "naturally occurring." The Examiner reiterated the Office's position that claims 42 and 43 would not be allowed due to the Office's adoption of a new policy specifically regarding the term "naturally occurring." The Office now believes that claims reciting the term are not allowable because a skilled practitioner would allegedly not be able to tell the difference between a naturally occurring and a non-naturally occurring product (in this case, a PTH receptor). Applicants stated during the interviews, and respectfully reiterate here, that they do not agree that this term renders the claims indefinite and submit that the Office has not presented proper legal grounds for rejecting these claims.

However, in the interest of moving this application toward allowance and as discussed during the interviews, applicants have amended these claims to delete the term "naturally occurring." Claim 42 now recites: "wherein the amino acid sequence is identical to the sequence of a fragment of a parathyroid hormone receptor." Amended claim 43 reads similarly, except that it recites a human parathyroid hormone receptor. In view of these amendments, applicants request that the present rejection be withdrawn.

The rejection of claims 40, 42, 43, 57, 58, 63, and 71 to 73 as allegedly indefinite for missing an "essential step" was also discussed. The Examiner indicated that the arguments presented in applicants' previous Amendment were persuasive on this issue. Thus, applicants request that this rejection be withdrawn.

II. Rejections under 35 U.S.C. § 112, first paragraph

Applicants also discussed with the Examiner the rejection of claims 40, 42, 43, 57, 72, and 73 as allegedly adding new matter. The Examiner indicated that the arguments presented in applicants' Amendment in Reply to Final Office Action were persuasive on this issue.

Accordingly, applicants request that this rejection be withdrawn.

The rejection of claims 40, 42, 43, 57, 58, 63, and 71 to 73 as allegedly lacking written description was also discussed. As applicants discussed in their previous Amendment, Examiner Eyler indicated (during an interview on September 18, 2002) that the present rejection under 35 U.S.C. § 112, first paragraph, is related to the rejection of the claims under 35 U.S.C. § 112, second paragraph, for use of the term "naturally occurring." As discussed above, applicants have amended the claims to delete the term "naturally occurring." Thus, applicants request this rejection be withdrawn.

The rejection of claims 40, 42, 43, 57, 58, 63, and 71 to 73 as allegedly not enabled was also discussed during the interviews. Examiner Pak indicated that the claims would likely be allowable if, for example, part (a) of each of these claims were amended to recite 30% sequence identity to the rat parathyroid hormone receptor (SEQ ID NO:20). Applicants have amended the claims as suggested by the Examiner and request that this rejection be withdrawn.

III. Rejection under 35 U.S.C. § 102

The rejection of claims 58, 63, and 71 as allegedly anticipated by Lindall et al. (U.S. Patent No. 4,508,828) was also discussed. The Examiner indicated that the amendments and arguments presented in applicants' previous Amendment were persuasive on this issue. Accordingly, applicants request that this rejection be withdrawn.

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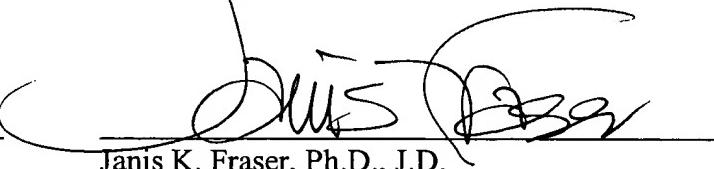
CONCLUSION

Applicants respectfully request that the proposed amendments be entered and that all claims be allowed. Enclosed is a check for \$950 for the Petition for Extension of Time fee. Also enclosed is a check for \$770 for the Request for Continued Examination fee. Please apply any other charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket No. 00786-071005.

Respectfully submitted,

Date:

May 20, 2004


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